Remarks

Claims 1-5 are pending.

In the Amendment After Final filed November 1, 2004, Applicants attempted amendments to simplfy the issues before the Examiner and to place the claims in condition for allowance.

It was attempted to cancel claims 1, to amend claims 2-5 and to add new independent claim 11.

Claims 2-5 were amended to depend on claim 11.

In new independent claim 11, most of the Markush structures of original claim 1 are no longer present. Only the Markush structures of formulae VIII and VIIIA remain. The attempted amendments would greatly reduce the claimed subject matter.

The Advisory Action dated December 16, 2004 stated that the proposed amendments will not be entered because they are not deemed to place the application in better form for appeal by materially reducing or simplfying the issues for appeal. The Examiner stated that:

- amended claim 4 does not differ in scope from claim 11 and

- the claims are not limited to the elected species, e.g. N,N,N',N'-tetramethyl-N,N'-bis-[2-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-ethyl]-hexamethylenediammonium dibromide (*sic*).

Applicants respectfully request the Examiner to reconsider and to enter the present amendments. Applicants believe this is warranted because:

- amended claim 4 in fact is more narrow than claim 11, aimed at compounds of formula VIII only and

- the attempted amendments would place the instant claims in better form for appeal as the scope of the claims would be greatly reduced from their original form.

Upon entering the attempted amendments, Applicants respectfully request the Examiner to reconsider the claim rejections and to allow claims 2-5 and 11. The following applies.

Claims 1-5 are rejected under 35 USC 102(e) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over WO 99/05108 and the U.S. equivalent, U.S. Pat. No. 6,254,724.

Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-41 of U.S. Pat. No. 6,254,724.

The Examiner states that the rejections will be dropped if the claims are limited to the elected specie.

This Applicants attempted to do, by limiting the present claims to compounds of formula VIII and also requesting consideration of the salts of formula VIIIA (compounds of formula VIIIA are salts of formula VIII when E is hydroxyl).

In an interview of January 4, 2005, the undersigned Agent and Examiner Alvo agreed to there being some confusion about what was the elected species.

Examiner Alvo believed the elected specie to be the single compound of N,N,N',N'-tetramethyl-N,N'-bis-[2-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-ethyl]-hexamethylenediammonium dibromide of working Example 18, while the undersigned believed it to be compounds encompassed by Markush structure VIII. Structure VIII is generic to the compound of working Example 18. Please see the response filed September 17, 2001.

Nevertheless, Applicants respectfully request that the attempted amendments in the Amendment After Final filed November 1, 2004 be entered, and also respectfully request that claims 2-5 and 11 be found allowable.

Applicants address the prior art WO 99/05108 and its U.S. equivalent, U.S. Pat. No. 6,254,724 as if the amendments are entered:

The present application is supported by provisional application No. 60/154,112, filed September 15, 1999.

WO '108 is published February 4, 1999 and has an international filing date of July 14, 1998. WO '108 qualifies as prior art under 35 USC 102(a). WO '108 does not designate the United States and therefore does not quality as prior art under 35 USC 102(e).

U.S. '724 has a filing date of July 20, 1998 and qualifies as prior art under 35 USC 102(e).

The Examiner has pointed out compound (g) of page 55 of WO '108 (col. 25 of U.S. '724) as the closest compound to that of the elected species. Applicants agree and assert that this is true for both the single specific compound of Example 18 and the general structures of formula VIII and VIIIA.

However, there is no specific overlap of compound (g) of WO '108 and U.S. '724 with any compounds of present structures VIII and VIIIA.

Further, Applicants assert that there is no possible overlap of any compounds disclosed in WO '108 and U.S. '724 with compounds of formulae VIII and VIIIA.

Therefore, there are no 35 USC 102(a) or 102(e) issues regarding the cited art.

Regarding obviousness under 35 USC 103(a), Applicants assert that as there is no possible overlap of any compounds disclosed in WO '108 and U.S. '724 with the present compounds of formulae VIII and VIIIA, that the present compounds cannot be obvious thereover. Applicants submit that there are no compounds described in the cited references that are encompassed by present formulae VIII and VIIIA. As there are no specific species disclosed in the cited art that are encompassed by the present genus, there can be no finding of prima facie obviousness.

In the Office Action dated December 2, 2003, the Examiner alleges that WO '108 provides motivation to modify compound (g) of page 55 therein to arrive at the present specie N,N,N',N'-tetramethyl-N,N'-bis-[2-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-ethyl]-hexamethylenediammonium dibromide. Applicants maintain that there is no suggestion in WO '108 or U.S. '724 to modify

compound (g) of page 55 of WO '108 and col. 25 of U.S. '724 in such a way to arrive at said specie or any of the present compounds. Please see the remarks in the Response filed June 14, 2004.

In any event, these obviousness rejections are not applicable as Dr. Glen T. Cunkle, an inventor of the present invention, is the inventor of compounds (a)-(j) of page 55 of WO '108 and col. 25 of U.S. '724. Compounds (a)-(j), inclusive of compound (g), then, are not invented "by another", and any rejections under 35 USC 102(a) or 102(e), or under 35 USC 103(a) as applied to 35 USC 102(a) or 102(e) are therefore overcome.

Please see MPEP 706.02(b), 715.01(a) and 716.10: "When subject matter, disclosed but not claimed in a patent application issued jointly to S and another, is claimed in a later application filed by S, the joint patent is a valid reference available as prior art under 35 USC 102(a), (e) or (f) unless overcome by affidavit or declaration under 37 CFR 1.131 showing prior invention (see MPEP 715) or an unequivocal declaration by S under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent".

A Declaration stating that Dr. Cunkle invented compounds (a)-(j) on page 55 of WO '108 was submitted with the Response filed June 14, 2004. Therefore compound (g) therein is not available as prior art and any 35 USC 102(a), 102(e) or 103(a) as applied to 102(a) or 102(e) rejections thereover are obviated.

To make the situation more clear, a further Declaration is attached herewith stating as such, and further making reference to the equivalent disclosure of U.S. '724.

In light of the above remarks and the newly submitted Cunkle Declaration, Applicants submit that any 35 USC 102(a), 35 USC 102(e) and 35 USC 103(a) as applied to 102(a) or 102(e) rejections are addressed and are overcome.

Present claims are also rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-41 of U.S. Pat. No. 6,254,724.

The present claims are directed only to compounds. The claims of U.S. '724 are directed to pulp or paper compositions and to methods of stabilizing pulp or paper. The present claims and the

claims of U.S. '724 are drawn to distinctly different subject matter. As such, there can be no improper extension of the right to exclude by issuance of the present claims.

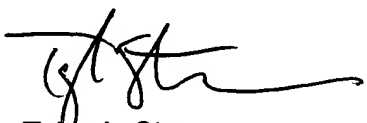
In view of this discussion, Applicants submit that any obviousness-type double patenting rejections are addressed and are overcome.

Further, there are no other patent applications assigned to Ciba Specialty Chemicals that disclose the claimed invention. Please see the discussion in the response filed September 12, 2003.

In view of all of the above, Applicants assert that claims 2-5 and 11 in their amended form are in condition for allowance and respectfully request that they be found allowable.

In the event that they are not found to be allowable, Applicants respectfully request that the amendments be entered for the purposes of appeal. Applicants submit that the amendments would place the instant claims in better condition for appeal as the issues are simplified.

Respectfully submitted,



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Attachment: Declaration under Rule 132
Petition for a one month extension